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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,136	10/23/2000	Herbert M. Straub	20003	9008

28133 7590 05/08/2002

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/08/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,136

Applicant(s)

STRAUB ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections – 35 USC 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 1, it is not clear if a “decorative molding wrapping foil” is being claimed as the invention or a “created laminated wrapping foil”.
- b. In claim 2, it is not clear if the “decorative molding foil, laminated wrapping foil or intermediate layered foil is being claimed as the invention.

Claim Rejections – 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suess et al. (U.S. 5,985,078) in view of Abrams (U.S. 5,908,527).

5. Suess discloses a metallic embossing foil (abstract) with carrier material that transfers colored layers on a surface (column 3, lines 42-44) conventionally used to wrap articles. Suess discloses a transparent layer applied to the colored layer applied by means of transfer foils which comprise a carrier film which are releasably disposed thereon to a hot embossing foil (column 3, lines 62-67). The reference discloses rolling a molded foil (column 4, lines 33-35) where the colored layer gives the foil a decorative pattern (column 4, lines 56-58 and column 7, lines 14-16). Suess discloses an adhesive layer on the foil (column 5, line 1). Suess does not disclose that the foil is used in foil wrapping of a substrate or as picture frame element or building trim piece. These features are directed to intended use of the claimed invention, which is given little patentable weight. Suess does not disclose the foil being laminated. Additionally the foil of Suess is used to wrap articles. Picture frame elements and building trim pieces are articles and so are included by the reference.

Abrams teaches a printed foil laminate (abstract and column 2, lines 12-15). Suess and Abrams are analogous art because they are from the same field of foils. It would have been obvious to one of ordinary skill in the art to laminate the embossed foil of Suess because Abrams teaches laminated foils maintain composure better during the rolling process.

Claim Rejections – 35 USC § 103(a)

✓ 6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams (U.S. 5,653,844) in view of Nelson (U.S. 4,724,026).

7. Abrams discloses a foil laminate with transfer printing (abstract) with impressions in the laminate (column 2, lines 4-5) leaving a decorative pattern with a suitable adhesive. Abrams

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discloses the molded foil laminate suitable to roll (column 2, lines 51-58 and column 4, lines 56-57) suitable to cover various packaging articles (column 7, lines 8-9). Abrams discloses a dry bond adhesive layer with an opaque colored material (column 7, lines 27-44). Suess does not disclose that the foil is used in foil wrapping of a substrate or as picture frame element or building trim piece. These features are directed to intended use of the claimed invention, which is given little patentable weight. Additionally the foil of Abrams is used to wrap articles. Picture frame elements and building trim pieces are articles and so are included by the reference.

Abrams does not disclose carrier stripped from the foil or clear and opaque properties.

Nelson teaches a metallic foil with a transfer sheet stripped away leaving a decorated sheet on the foil (column 2, lines 40-50) along with a clear or colored coating, a release coat and a carrier film (column 3, lines 39-42) on the foil. Abrams and Nelson are analogous art because they are from the same field of foils. It would have been obvious to one of ordinary skill in the art to include the carrier and release layers with clear or colored coatings in the foil laminate of Abrams because Nelson teaches these layers improve the decorative properties of the film rendering the foil more marketable.

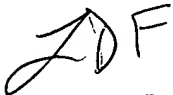
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

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The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

